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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**Docket Number (Optional)  
7836/84512USC1

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on 15 January 2009

Signature

Typed or printed

name Catherine FascettaApplication Number  
10/025,155Filed  
18 December 2001First Named Inventor  
HEINZ et al.Art Unit  
3662Examiner  
Dao Linda Phan

Applicant requests review of the rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant /inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 37,135☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

Signature

L. Friedman

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Telephone number

15 January 2009

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

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\*Total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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REASONS THAT PRE-APPEAL BRIEF REVIEW IS REQUESTED

Claims 22-45, 47-56 and 58-63 are pending. The last Office Action (in a series of about a dozen) mailed 22 December 2008 indicated that claims 22-42 are allowed and rejected claims 43-45, 47-56 and 58-63 under 35 USC §135(b)(1). It never stated but implied that the rejected claims were not present in the captioned application within one year of the 25 October 2001 publication date of application No. 09/817,268.

**1. CLAIMS 43-45 WERE PRESENTED IN MARCH 2002**

Claims 43-45 were presented in a 13 March 2002 amendment that was received at the PTO on 25 March 2002, less than one year after the 25 October 2001 publication date of application No. 09/817,268 ("the '268 application") and less than one year after the 29 May 2001 issuance of Pat. No. 6,239,744 ("the '744 patent"). On its face, there is no justification for the rejection of claims 43-45.

**2. EACH OF CLAIMS 47-56 AND 58-63 EITHER WAS PRESENTED, OR IS ENTITLED TO THE EFFECTIVE DATE OF AN EARLIER CLAIM THAT WAS PRESENTED, WITHIN ONE YEAR OF A PUBLISHED CLAIM OF SUBSTANTIALLY THE SAME SUBJECT MATTER**

The Office Action ignores that 135 USC §135(b)(1) and (2) each measures a one year period based on subject matter corresponding with what is published in the document marking the beginning of the one year. That is, §135(b)(1) measures time from the date a patent issues, and measures a claim against a claim of that patent; while §135(b)(2) measures time from the date an application is published, and measures a claim against a claim of that published application. It appears that the Office Action is erroneously trying to measure time from the 25 October 2001 publication date of the '268 application, but to measure the claims against the claims as issued (Pat. No. 6,677,896 ("the '896 patent")) on 13 January 2004.

Claims 47-56 and 58-63 were presented in a 20 April 2004 amendment, less than one year after the 13 January 2004 issuance of the '896 patent.

The unsupported basis for the rejection appears to be the implied assertion that each of claims 47-56 and 58-63 has substantially the same subject matter as a claim of the published '268 application. To the extent that is true of any of claims 47-56 or 58-63, then all the material limitations of that claim are present in, or necessarily result from, the limitations of one of claims 22-30 and 43-45 that were presented in the March 2002 less than one year after the October 2001 publication date of the '268 application. The correspondence of claims 22-30 and 43-45 with claims of the published '268 application was identified in a table on page 3 of applicants' March 2002 request for an interference. Furthermore, to the extent that the limitations of any of claims 47-56 or 58-63 are present in, or necessarily result from, the limitations of one of the earlier presented claims, the later presented claim gets the benefit of the date of the earlier claim for purposes of §135(b). Consequently, it would have an effective date within a year of the October 2001 publication of the '268 application and would not be barred by §135(b). *See e.g. In re Berger*, 279 F.3d 975, 981-82, 61 USPQ2d 1523, 1527 (Fed. Cir. 2002).

The applicants cannot know the actual reasoning underlying the rejection of any claim, since the Office Action did not identify any claim of the published '268 application that has substantially the same subject matter as any of claims 47-56 and 58-63. Nonetheless, it is noted that each of claims 47-53 and 58-63 has limitations that are different than any single claim of the '268 application, and that the limitations of claims 54-56 are present in, or necessarily result from, the limitations of claims 43-45, respectively, that were presented within one year of

the publication of the '268 application. Therefore, the §135(b) rejection is unfounded.

### 3. REGARDING THE COUNT

The Office Action objected to the proposed count and to the request for an interference.

The Office Action stated that the proposed count is not considered a count because claims 22-30 are not patentable. However, the Office Action allowed claims 22-30, so the applicants do not understand that objection.

In general, a "count" means the Board's description of interfering subject matter. 37 CFR §41.201. Also in general, a claim corresponds to a count if it does not define an invention that is patentably distinct from the invention defined by the count. *See e.g. Orikasa v. Oonishi*, 10 USPQ2d 1996, 2004 (Comm'r 1989). It is noted that the correspondence of claims 22-45 with claims of the '744 patent and the correspondence of claims 47-56 and 58-63 with claims of the '896 patent were identified in a table on pages 3-4 of applicants' April 2004 request for an interference. A proposed count was attached to that request, and the legal basis for the format of that proposed count was identified on page 2 of that request (citing *Orikasa*, 10 USPQ2d at 2003, and *Davis v. Uke*, 27 USPQ2d 1180, 1188 (Comm'r 1993)). The correspondence of the claims to that proposed count was identified on pages 2-5 of that request. In general, the reason was that none was patentably distinct from the proposed count.

### Conclusion

For the foregoing reasons, the basis for the rejection is unfounded and the claims are allowable. If the PTO believes there is interfering subject matter, then

an interference should be declared. If a telephone conference would expedite such a declaration, the applicants respectfully request that a telephone call be made to the undersigned. If the PTO does not believe there is interfering subject matter, then the applicants respectfully request a notice of allowance.

Respectfully submitted,



L. Friedman

Reg. No. 37,135

15 January 2009

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